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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,179	08/06/2001	Lynn Henry Wheeler	10399-34382	2029
26702	7590	08/03/2005	EXAMINER	
MORRIS, MANNING & MARTIN LLP 6000 FAIRVIEW ROAD SUITE 1125 CHARLOTTE, NC 28210			ZAND, KAMBIZ	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,179

Applicant(s)

WHEELER ET AL.

Examiner

Kambiz Zand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-67 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2-33 and 37-67 is/are rejected.
7) ☒ Claim(s) 34-36 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 08/01/05 enclosed.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claims 1 and 68-87 have been withdrawn. **Examiner suggests the cancellation of the claims 1 and 68-87 by Applicant in Applicant's response to this office action in order to clarify the final status of the claims.**
4. Claim 2 has been amended.
5. Claims 2-67 are pending.
6. Examiner withdraws objection to the drawings and specification due to correction by the applicant.
7. Examiner withdraws rejection the double patenting rejections of claims 2-67 due to Approval of Applicant's Terminal Disclaimer filing on 05/23/2005 with respect to U.S. Patent No. 6,820,199; 6,789,189 and 6,820,202 & Applicant's persuasive arguments with respect to application number 10/248, 623.

Response to Arguments

8. In response to applicant's arguments, the recitation "operating by a third party a database for accounts, wherein information pertaining to each

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account is retrievable from the database based on a unique identifier for that account” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

9. As per Applicant's arguments with respect to the location of the database, Examiner considers the location of the database as irrelevant since it is only a design choice where one can consider a system or node within a network as client or server or a node and where they can further be called any names one desire them to be. Having a database in a third party device does not distinguish the claimed apparatus, method and system from the prior art if prior art has the capability to do so perform (See MPEP 2114 and *Ex Parte Masham*, 2 USPQ2d 1647 (1987)). The prior art is replete with references disclosing database used to store information (sensitive, encrypted or otherwise normal data). Further more col.3, lines 38-41 of Elgamal disclose the system may be three, four or more-way communication protocol.
10. with respect to association of public key with a device regardless if we call it first or second or third party is similar to 10 above and therefore please

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see MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987). Further more col.3, lines 38-41 of Elgamal disclose the system may be three, four or more-way communication protocol.

11. Applicant's arguments with respect to the added limitation "without the need for a digital certificate" into claim 2 has been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

12. **Claims 2-21, 23, 24-29-33 and 38** are rejected under 35 U.S.C. 102(b) as being anticipated by Elgamal (5,671,279).

As per claims 2, 8 and 9 Elgamal (5,671,279) teach a method of operating by a third party (see col. 6, line 67 and col. 7, line 1) a database for accounts, information pertaining to each account being retrievable from the database based on a unique identifier for that account (see col. 6, lines 56-58), comprising the steps of:

(a) first associating by the third party a public key of a respective public-private key pair with each unique account identifier (see col. 6, lines 56-58 and 66; col. 7, lines 1 and 52-56 and col. 10, lines 20-23), and thereafter

(b) performing entity authentication by the third party with respect to an electronic communication that is received by the third party (see col. 4,

lines 41-44 and col. 5, lines 1-6) and that includes both a unique account identifier and a digital signature for a message regarding the account associated with the unique account identifier (see col.5, lines 20-31 and col. 6, lines 56-58 and 34-40) , the entity authentication consisting of solely conducting message authentication only using the digital signature received in each electronic communication (see col. 6, lines 37-38) and the public key associated with the unique account identifier accompanying the digital signature (see col. 34-37), and without the need for a digital certificate (see col.5, lines 1-6 where it disclose authenticating messages using digital signature; lines 6-23 disclose authenticating the digital signature and the association of the public key and the digital certificate that corresponds to the public key for checking the integrity of the message, however col.7, lines 8-13 disclose the authenticity of the receipt using digital signature and examiner considers such receipt as a message and therefore the message authentication could be done by signature authentication). Also see col.4-36 for detail with respect to claims 8 and 9.

As per claim 3-4 Elgamal (5,671,279) teach the method of claim 2, wherein the third party is an account authority and financial institution (see col. 3, lines 31-33 and col. 6, lines 55-57).

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As per claim 5 Elgamal (5,671,279) teach the method of claim 3, wherein one of the public keys associated with an account is obtained from an account holder for that account (see col. 5, lines 9-12).

As per claims 6-7 and 24 Elgamal (5,671,279) teach the method of claim 3, wherein a public key associated with an account is obtained from a manufacturer of a device/ a distributor of a device that generates digital signatures using the corresponding private key (see col. 6, lines 34-36 and 41-53 where the key is an electronic key).

As per claim 10 Elgamal (5,671,279) teach the method of claim 2, wherein the information includes an account number (see col. 6, line 3).

As per claim 11-12 Examiner takes official notice that checking on current balance and available credit during authorization process of a purchase is well known in the art.

As per claims 13 Elgamal (5,671,279) teach the method of claim 2, wherein the information includes a list of associated to accounts (see col. 6, lines 4-6).

As per claim 14 Elgamal (5,671,279) teach the method of claim 2, wherein the information includes a name of an account holder (see col. 6, lines 4-8).

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As per claim 15 Elgamal (5,671,279) teach the method of claim 2, wherein the information includes an address of an account holder (see col. 6, line 4).

As per claims 16-17 Elgamal (5,671,279) teach the method of claim 2, wherein the information includes a social security number and a tax identification number of an account holder (see col. 5, line 27).

As per claim 18, 37 and 38 Elgamal (5,671,279) teach the method of claim 2, wherein the information regards a device containing a private key corresponding to the public key (see col. 5, lines 8-9).

As per claim 19 Elgamal (5,671,279) teach the method of claim 2, wherein the information includes security features of a device (see col. 4, lines 12-16).

As per claim 20 Elgamal (5,671,279) teach the method of claim 2, wherein a digital signature is generated within a device (see fig. 1; col. 3, lines 66-67 and col. 4, lines 1-32) where each device (merchant, customer and financial institution or third party create their digital signature).

As per claims 21, 23 and 29-33 Elgamal (5,671,279) teach the method of claim 20, wherein the device comprises a personal computer (see col. 3, line 54), credit card and debit card and other IC type chips used in the other type of devices

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such as PDA, ID badge, security cards, and other smart cards (see col. 3, line 59).

Claim Rejections - 35 USC § 103

13. **Claims 2-33 and 37-67** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis (6,213,391 B1) in view of Eldridge et al (6,061,799 A).

As per claims 2-33 and 37-67 Lewis (6,213,391 B1) teach a method of managing an account in a database, comprising the steps of: recording information pertaining to each of the accounts in the database of an account authority (see abstract; col.3, lines 36-67; col.4, lines 1-13); and assigning a respective unique identifier to each account such that information pertaining to each respective account is retrievable from the database based on its unique identifier (see col.3, lines 36-67; col.4, lines 1-13 and 26-39 where the unique identifier is biometric or other unique information of the users and it is retrievable based on that unique identifier). Lewis also teach that such unique identifier may be used to access number of user's accounts in line 13-19 of col.4 where one code is used to access multiple accounts of a user. Lewis (6,213,391 B1) also teach wherein a unique identifier comprises unique characteristics of the user such as biometric information, identification profile that could be numeric, alphanumeric, or other digital representation of the user's unique biometric or

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digital signature profile in col.3, lines 36-67 and col.4, lines 1-2 and therefore Lewis teach information that is account number, current balance, available credit, associated accounts, name, address, tax identification, all numeric or alphanumeric or other digital representation of the user's unique identification but do not disclose associating the same public key of a public-private key pair with a plurality of unique identifier; a device possessing the private key used to generate a digital signature of an electronic message; information includes security characteristics of a device possessing the private key used to generate a digital signature of an electronic message; the step of associating a public key with a unique identifier comprises recording the public key with the information retrievable based on the unique identifier; and electronic message includes no account-identifying information other than a unique identifier of an account. However Eldridge et al (6,061,799 A) teach association of unique identifier with public-private key as shown in fig.3a and a device possessing the private key used to generate a digital signature of an electronic message; information includes security characteristics of a device possessing the private key used to generate a digital signature of an electronic message; the step of associating a public key with a unique identifier comprises recording the public key with the information retrievable based on the unique identifier; and electronic message includes no account-identifying information other than a unique identifier (see fig.3a; col.5, lines 4-9 where at least one record includes account information such as client id file and client unique identifier such as password; see fig.3a where stored client file includes public-private key and public key identifier of the

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client; also see col.5, lines 35-55; see col.5, lines 56-67; col.6, lines 1-26 where the digital signature such as DDS may be employed as an option in encryption process and transmission of encrypted message; and col.6, lines 52-67; col.7, lines 1-14; see col.7, lines 18-48 and col.10, lines 23-52 and fig.2; col.3, lines 48-67; col.4, lines 1-14; col.6, lines 12-19; and where the fig.2 also clearly shown more than one server process or a third party that also represent the above limitations). Therefore Eldridge teach the unique id correspondence to public-private key to a device or a third party device and on the other hand Lewis teach how using the same unique id corresponds to number of accounts of a user. It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Eldridge's public-private key link to the unique identifier in Lewis personal identification system that is based on distinctive characteristics of the user in order to retrieve the same public key that corresponds to unique identifier from the database in order to generate encrypted data, digital signature in a secure manner. It would have been obvious also to one of ordinary skilled in the art to utilize the above method in well known portable devices such as PDA, smart cards such as credit cards and debit cards, dangle, touch screen portable PDA or other portable devices including jewelry in order to communicate wirelessly between the portable device and a host to implement the above method as being disclosed by Lewis (6,213,391 B1) in view of Eldridge et al (6,061,799 A) retrieve the same public key that corresponds to unique identifier from the database in order to generate encrypted data, digital

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signature in a secure manner. Also see the entire patents for detailed description of the above limitations.

Allowable Subject Matter

14. **Claims 34-36** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kambiz Zand

08/01/2005

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